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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/851,848

05/09/2001

Andrew C. Gilbert

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3671

1473

7590

06/19/2006

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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,848

Applicant(s)

GILBERT ET AL.

Examiner

Olabode Akintola

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 and 23-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/02 & 3/25/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication filed on May 9, 2001. Claims 1-31 are pending in the application are subject to restriction/election as discussed below.

After a phone call on May 23, 2006, a provisional election was made by Mr. Hassan Albakri (Attorney for the Applicants) to prosecute claims 1-11 and 19-22. Accordingly claims 12-18, 23-29, 30 and 31 are withdrawn from consideration as being directed to non-elected invention. Applicant is respectfully requested to cancel the withdrawn non-elected claims 12-18, 23-29, 30 and 31 of inventions II-IV in response to this office action. Claims 1-11 and 19-22 have been examined. The restriction/election and rejections are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: (Claims 1-11, 19-22) is directed to method and system for manipulating electronic trading market that suspends trading if a price difference between first and second bids is greater than a price amount.

Invention II: (Claims 12-18, 23-29) is directed to a system and method for manipulating electronic trading market that automatically providing a bid-offer period upon completion of the trading period.

Invention III: (claim 30) is directed to method for controlling manipulating of a market comprising canceling the first bid or offer if the market for the bid or offer is illiquid.

Invention IV: (claim 31) is directed to “*method*” for controlling manipulating of a market comprising receiving a request to submit a bid or offer at any time to promote liquidity.

3. The inventions I through IV are distinct, each from the other because of the following reasons:

Inventions I and IV are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable.

In the instant case,

Invention I has separate utility from inventions II-IV such as suspending trading if a price difference between the first bid or offer and a second bid or offer is greater than a price amount.

Invention II has separate utility from inventions I and III-IV such as automatically providing a bid-offer period upon completion of the trading period.

Invention III has separate utility from inventions I-II and IV such as canceling the first bid or offer if the market for the bid or offer is illiquid.

Invention IV has separate utility from inventions I-III such as receiving a request to submit a bid or offer at any time to promote liquidity.

After a phone call on May 23, 2006, a provisional election was made by Mr. Hassan Albakri (Attorney for the Applicants) to prosecute claims 1-11 and 19-22. Accordingly, claims 12-18, 23-29, 30 and 31 are withdrawn from consideration as being directed to non-elected invention. Applicant is respectfully requested to cancel the withdrawn non-elected claims 12-18, 23-29, 30 and 31 of inventions II-IV in response to this office action. Claims 1-11 and 19-22 have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-11 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden et al. (U.S. Patent Application No. 20010032175) in view of Keiser et al. (U. S. Patent No. 6505174).

Re claims 1, 7-11, 19-22: Holden teaches a method for controlling manipulation of an electronic trading market by a trader comprising: receiving a request to cancel a first bid or offer (section [0073]; *the bidder sends a request to erase the bid*). Holden does not explicitly teach suspending trading if a price difference between the first bid or offer and a second bid or offer is greater than a price amount; wherein suspending trading comprises preventing a second trader from responding to the second bid or offer; wherein suspending trading further comprising setting a cooling off period; allowing the second trader to respond to the second bid or offer upon completion of the cooling off period; wherein the price amount is determined by the electronic trading system; allowing a second trader to respond to the second bid or offer if the price difference is less than the price amount.

Keiser teaches suspending trading if a price difference between the first bid or offer and a second bid or offer is greater than a price amount (col. 4, lines 39-42); wherein suspending trading comprises preventing a second trader from responding to the second bid or offer (col. 4, lines 41-43); wherein suspending trading further comprising setting a cooling off period (col. 4, lines 43-45); allowing the second trader to respond to the second bid or offer upon completion of the cooling off period (col. 4, lines 43-45); wherein the price amount is determined by the electronic

trading system (col. 4, lines 35-36); allowing a second trader to respond to the second bid or offer if the price difference is less than the price amount (col. 4, lines 39-45). It would have been obvious to one of ordinary skill in the art to modify Holden to include the steps of suspending trading if a price difference between the first bid or offer and a second bid or offer is greater than a price amount; wherein suspending trading comprises preventing a second trader from responding to the second bid or offer; wherein suspending trading further comprising setting a cooling off period; allowing the second trader to respond to the second bid or offer upon completion of the cooling off period; wherein the price amount is determined by the electronic trading system; allowing a second trader to respond to the second bid or offer if the price difference is less than the price amount as taught by Keiser. One would have been motivated to these in order to avoid wild fluctuations in price due to market manipulation by an individual or group of traders by providing the system with some price control mechanism (col. 4, lines 9-14).

Re claim 2: Holden teaches determining if a first trader has submitted both the first bid or offer and the second bid or offer (section [0026]; *a subsequent offer from a given user replaces the user's existing bid*).

Re claim 3: Holden teaches canceling the first bid or offer (section [0073]; *moderator can cancel bid*).

Re claim 4: Holden teaches indicating that the first bid or offer was canceled (section [0026]).

Re claim 5: Holden teaches replacing the first bid or offer with the second bid or offer (section [0026]).

Re claim 6: Holden teaches enabling the second bid or offer to be traded (section [0026]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OA



HANI M. KAZIMI
PRIMARY EXAMINER